

## **REMARKS**

Claims 1-35 are pending in this application, all of which stand rejected. Following entry of the amendment, claims 1, 8,13, and 17 will have been amended to more particularly point out the invention, and claim 14 will have been cancelled.

As a result of the August 20, 2004 Office Action, claim 17 stands rejected under 35 U.S.C. § 101; claims 1-3, 7-17, 25-33, and 35 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,331,865 (Sachs); claims 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sachs in view of U.S. Patent No. 6,324,288 (Hoffman); claim 34 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sachs in view of Official Notice.

Applicants has cancelled claim 14, which renders the rejection of claim 14 moot. Applicants note that substantially the material from claim 14 has been added to claim 13.

Applicants have amended claim 17 to recite a computer-readable medium, which addresses the section 101 rejection of claim 17.

As to the remaining claims that are pending, applicants traverse the grounds for rejection as set forth below.

The present application discloses a mechanism for providing a shopping service within an application. The archetype of this mechanism is an electronic book rendering application that provides the opportunity to buy electronic books from within the application, although the disclosure is not limited to the electronic book scenario. As explained in the background section of the application, one deficiency of prior art systems is that – to the extent that they provide any shopping at all from within the application – the prior art systems hard code the address of the retail web site into the application. This hard-coding of the address makes it difficult to expand, or otherwise change, the set of retail sites at which the user can shop from within the application. The disclosure provided in the present application addresses this deficiency by including in the application the address of a directory service (or including some other means to access the directory service). The directory service then includes a list of various retail sites that the user can access. The user's machine maintains, preferably in its registry, a personal list of the retail web sites that the user will be able to

access. The directory service allows the user to add new web sites to the user's personal list, and the set of web sites on the user's list are constantly able to change.

The Sachs reference is generally directed to electronic books and the purchase of electronic content. Sachs arguably allows the user some flexibility in terms of what "bookstores" the user will be able to access from within an electronic book device, but addresses this issue in a different manner from what the present application discloses and claims. In particular, Sachs includes an "information services system 20" that is accessible to the electronic book device (10). The information services system 20 includes a directory 26 of bookstores that the user can access from the electronic book device. Sachs is unclear about the mechanism by which the user is given access to information services system or to the bookstores specified in the directory.

With that background, applicants wish to focus the Examiner's attention on the following features of the claimed invention. Applicants submit that these features are not taught in any of the prior art applied by the Examiner:

**Claim 1**

Claim 1 is directed to a method. The method comprises storing a list of web sites that distribute digital content on a first device, and providing a set of computer-executable instructions to a plurality of second devices. The instructions provided include the network address of the first device.

As noted above, Sachs is unclear as to how the user is enabled to access the bookstore or the information services system. Claim 1 recites a particular way of giving the second device access to the list of web sites that distribute content: it includes the address of the device that contains that list in the very application that will ultimately perform the rendering of digital content. Even if one assumes that Sachs' directory 26, stored on information services system 20, corresponds to the claimed first device that stores a list of web sites, and even assuming that Sachs' electronic book devices are the claimed "second devices," Sachs does not provide software to the electronic book devices, where the software includes the address of the information services system. In fact, Sachs' does not describe any specific mechanism by which the electronic book device is enabled to access the information services system. None of the other applied references teach this feature either.

Thus, applicants respectfully submit that claim 1 recites features not taught or suggested by the applied prior art, and respectfully requests reconsideration of the rejection of claim 1.

**Claim 7**

Claim 7 is dependent on claim 1. Inasmuch as claim 1 calls for storing a list of web sites on a first device, claim 7 further calls for the storing act to comprise storing a graphical image for each of the web sites.

Sachs is unclear as to what information is stored about each of the bookstores in directory 26. In any event, Sachs does not state that a graphical image is stored for each of the bookstores. Thus, even if one assumes that the list stored in claims 1 and 7 corresponds to Sachs' directory 26, Sachs does not teach the features of claim 7 because, at a minimum, Sachs does not teach that a graphical image is stored for each bookstore in the directory. Notwithstanding the fact that Sachs mentions "graphical and pictorial information," this mere mention of such information is not the same as storing a graphic for each bookstore in the directory. Sachs refers to such "graphical and pictorial information" as a type of digital content that can be distributed. Sachs does not mention that such information is part of the directory of bookstores that distribute such digital content. Since the "graphical information" feature recited in claim 7 is not identically taught by Sachs, the Examiner has not demonstrated anticipation with respect to that claim.

Accordingly, applicants respectfully request that the rejection of claim 7 be reconsidered and withdrawn.

**Claim 8**

Claim 8 is dependent on claim 1, and calls for limiting the set of web sites on the list recited in claim 1 to web sites that distribute or vend content that can be rendered by the computer-executable instructions provided in claim 1. None of the applied prior art teaches limiting the web sites on a list on this basis. Accordingly, applicants respectfully submit that claim 8 is patentable over the applied prior art.

**Claim 13**

Claim 13 is directed to a method, and recites receiving a request to add a web site to a list stored on a computing device, and then uploading data indicative of the added web site to the computing device. The list is stored in a registry on the computing device, and the web site that is being added to the list is one that distributes or vends digital content.

The crux of the rejection of claim 13 is that, in Sachs, “when the owner of the computing device initially activates service, the owner inherently requests the addition of web sites to a list on the device via directory 26.” The Examiner does not specific on which “computing device” service is being activated, but it appears to be the electronic book device.

Applicants have not been able to locate any teaching in Sachs to the effect that activating service on an electronic book device causes web sites from directory 26 to be “added” to anything – much less to the electronic book device itself. The fact that the Office Action asserts that this feature is “inherent” seems to confirm that it is not explicitly mentioned in Sachs. In any event, anticipation by inherency requires that the inherent element be necessarily present, and not merely possibly or probably present. As noted above, Sachs is unclear as to how the electronic book device accesses the bookstore from the directory. One way would be to store the bookstore’s address on the electronic book device. However, this is not the only way. As an alternative, the information services system could redirect the electronic book device to the bookstore without ever providing the bookstore’s address to the electronic book device. Sachs is not specific as to whether the address of the web site is stored. Claim 13, on the other hand, is specific. Claim 13 thus recites a claim feature that is not taught in the applied reference, and the Examiner has not demonstrated inherency under the relevant legal standard.

Accordingly, applicants respectfully request that the rejection of claim 13 be reconsidered and withdrawn.

Additionally, inasmuch as claim 17 is a computer-readable medium claim with features similar to claim 13, applicant respectfully submits that claim 17 is allowable as well.

**Claim 25**

Claim 25 is directed to a method of facilitating electronic commerce. In essence, claim 25 calls for storing some data indicative of commerce sites in a predetermined location

on a “second computing device”; engaging in communication with one of the commerce sites whose indicative data is stored at such a predetermined location; and excluding contact with sites whose data is not stored at the predetermined location. In other words, the predetermined location essentially determines which sites can be contacted.

Sachs does not teach these features. Even if one assumes that Sachs’ bookstores are commerce sites, and even assuming (as the Examiner has done) that the electronic book device 10 is the claimed “second computing device,” Sachs does not teach that data indicative of the bookstores is stored in a predetermined location on the electronic book devices. As noted above, Sachs states that the electronic book device can communicate with the bookstore, but is non-specific about how this communication is made, or about what information the electronic book device stores about the bookstore. Additionally, since Sachs does not teach information indicative of the bookstores is stored on the electronic book device in a pre-determined location, it also does not teach the feature of “excluding contact” with devices that are not stored in such a location.

Accordingly, the applied prior art does not anticipate claim 25, and applicants respectfully request that the rejection of claim 25 be reconsidered and withdrawn.

**Claim 30**

Claim 30 is directed to a method of purchasing digital content. Claim 30 refers to three computing devices: the first computing device runs a content-rendering program. The first computing device stores the address of a second computing device. Additionally, an address of a third computing device is obtained from the second computing device, and the content-rendering program (at the first computing device) is used to place an order for digital content with the third computing device. Based on these features of the three devices, the Examiner has considered the first device to be Sachs’ electronic book device; the second device to be the information services system; and the third device to be the primary bookstore.

Even if one assumes that these analogies to Sachs are correct, Sachs does not teach the features of claim 30. As noted above, there is no teaching in Sachs that the electronic book device (first device) stores the address of the information services system (second device). Moreover, there is no teaching in Sachs that that the electronic book device obtains

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the address of the bookstore from the information services system. Sachs is silent as to whether, or how, these addresses are communicated to the various devices. Thus, Sachs does not identically teach the features of claim 25.

Accordingly, applicants respectfully request that the rejection of claim 25 be reconsidered and withdrawn.

**No new matter**

Applicants respectfully submit that the amendments to the claims do not constitute new matter. At a minimum, the amended material is supported by pages 5 and 12-13 of the original application.

**Conclusion**

For all of the foregoing reasons, applicants respectfully submit that the claims discussed above are patentable over the applied prior art, and that the remaining claims are patentable at least by reason of their dependency. Applicants request reconsideration of the Office Action, and submit that the pending claims are in condition for allowance.

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